

REMARKS

Inasmuch as Applicants have not received a response to their Request for Complete Office Action, and inasmuch as the time period continues to run in this application, Applicants are replying herein in order to avoid further fees for extensions of time. However, please see the comments concerning the rejection of claim 10, below, which claim has previously been discussed in the Request for Complete Office Action filed March 28, 2006.

The issues outstanding in the Final Rejection mailed March 8, 2006, are the information disclosure statement, the rejection under 35 U.S.C. §112, and the rejection under 35 U.S.C. §103. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

Information Disclosure Statement

The DE 195 41 128, and Derwent abstract listed in the Information Disclosure Statement of September 15, 2003, remains uninitialed. It is again respectfully submitted that, inasmuch as these references were properly of record in the parent application, they *must* be made of record by the Examiner herein. For example, the M.P.E.P. §2001.06(b) states that, "if the application under examination is identified as a continuation, divisional, or continuation in part of an earlier application, the Examiner will consider the prior art cited in the earlier application.

...Accordingly, no separate citation of the same prior art need be made in the later application."

In any event, in order to expedite formally making of record the two above noted documents, a copy of the Derwent Abstract, along with the PCT Search Report which caused the DE to be made of record in the parent, is provided herewith. In the Search Report, the DE is cited in category A, Technological Background; page 2, lines 4-50 and example 5 are noted with respect to claims 1 and 2 of the PCT application. An additional Form-1449, listing these two references, is also provided for the Examiner's initials.

Rejection under 35 U.S.C. §112

Applicants disagree with this analysis, for the reasons of record, the noted language in the claim has been canceled. Withdrawal of the rejection is therefore respectfully requested.

Rejection under 35 U.S.C. §103

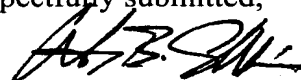
Claim 10 has been rejected under 35 U.S.C. §103 over Reynolds et al. '332 taken with Israel (GB '574). Reconsideration of this rejection is respectfully requested.

Solely claim 10 is rejected over art. However, claim 10 is, in fact, *narrower* than claim 1, inasmuch as claim 1 recites that the compound "consists essentially of levo-thyroxine sodium" while claim 10 recites that the compound "consists essentially of levo-thyroxine sodium and liothyronine sodium". Thus, claim 1 encompasses levo-thyroxine sodium, and materials which do not change the basic and novel characteristics of the product. See *PPG Industries Inc. v. Guardian Industries Corp.*, 156 F.3d 1351, 48 U.S.P.Q. 2d 1351 (Fed. Cir. 1998). Liothyronine sodium is clearly not excluded from claim 1, since it can be employed in the composition, evidenced by the specification and claim 10. Thus, claim 10 is *narrower* than claim 1, because whereas claim 1 specifies only one component, and materials which not deleteriously effect the composition, claim 10 requires two components, and materials which do not deleteriously effect the composition. Accordingly, for the same basis that claim 1 is allowable, claim 10 also is necessarily allowable. Withdrawal of the rejection under 35 U.S.C. §103 is respectfully requested.

The claims in the application are submitted to be in condition for allowance. However, should the Examiner have any questions or comments, she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Harry B. Shubin, Reg. No. 32,004
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-2168-D01

Date: July 24, 2006

HBS:blb

K:\Merck\2000 - 2999\2168\D1\reply to final rejection 72006.doc